



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 12

In re Application of
Bryan Bergeron
Application No. 09/992,328
Filed: November 19, 2001
Attorney Docket No. 7436-1

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: DECISION ON PETITION
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This is a decision on the petition filed on November 4, 2002 by which petitioner requests supervisory review of the examiner's final restriction requirement, and certain specific relief therefrom. In addition, petitioner requests relief from the examiner's refusal to enter proposed formal drawings as defining new matter. No fee is required for the petition, and a refund of the \$130.00 petition fee tendered with the petition will be scheduled.

The petition is granted-in-part.

In paper No. 3, the examiner promulgated a requirement that petitioner elect between claims 1-10, drawn to a drinking container and claims 11-17, drawn to a method of using a drink container. The examiner further required (presumably in the event of an election of the container claims), that petitioner elect between the species of "Group A" which was stated to comply with Figures 2A and 2B, and the species "Group B" of Figures 4A and 4B.

In paper No. 4, petitioner elected the claims drawn to the drinking container, and traversed the requirement to elect between the container claims and the method claims. Petitioner further elected the species of "Group A", noting that the election was "without traverse." Petitioner identified all of the container claims as "reading on" the elected species with the exception of claim 7.

In paper No. 5, the examiner, opined that Figures 2A and 2B "do not show a wedge shaped fluid diverter as claimed in claims 2 and 8-10, do not show a flow channel extending lengthwise along an outer surface of said fluid diverter member as claimed in claims 3 and 8-10 and do not show an extension spout as claimed in claims 6 and 8-10." The examiner accordingly held that claims 2, 3, 6 and 8-10 did not read on the elected species, and that only claims 1, 4 and 5 read on the elected species. The examiner proceeded to act only on claims 1, 4 and 5.

Petitioner argues that the requirement to elect between the container claims and the method claims was erroneous because petitioner disagrees with the examiner's holding that the drinking cup can be used as other than a drinking cup, and therefore, in a method other than the recited method of claims 11-17. Petitioner categorizes the examiner's example as removing meaning from the statutory requirements of 35 USC § 121. Petitioner further argues that the examiner has not provided reasons for insisting upon restriction as required by MPEP § 808.02.

A review of the requirements set forth in the relevant portions of Chapter 800 of the Manual of Patent Examining Procedure shows that the examiner's restriction requirement between claims 1-10 as drawn to a drinking container and claims 11-17 as drawn to a method of using that container to drink as performed by a "disabled user" is perfectly proper. It is clear that the drinking container, as claimed, can be used in a literal plethora of methods, some related to utility with fluids, others having nothing to do with fluids. An example of the former would

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be one as provided by the examiner. Another example would be to use the container to water one's flower bed. An example of the latter would be to use the container to store items within. Petitioner is neglecting that as a general rule, a statement of intended use "drinking container for assisting a disabled person in drinking a fluid by reducing the degree of tilt necessary to drain the fluid from the container into the person's mouth" would not necessarily distinguish over a reference showing all of the positively recited structure following the word "comprising" in the claim. Such a reference might well render the structural claim unpatentable under 35 USC § 102, while failing to have anything at all to do with the patentability of the method of use claims. Office practice is very specifically discussed in MPEP § 806.05(e) and MPEP § 806.05(h), and whether petitioner chooses to categorize the invention of claims 1-10 as and apparatus for performing the process of claims 11-17, or as a product which performs the method of claims 11-17, it is clear that the examiner has demonstrated that patentability of the process (how the apparatus or product would be used) is a distinct matter from the issue of patentability of the apparatus (or product) *per se* in a manner which satisfies Office practice. Furthermore, petitioner's argument *vis-a-vis* failure to demonstrate a reason for insisting on restriction as required by MPEP § 808.02 is not understood. The examiner has indicated a separate classification for the method and the product (or apparatus); MPEP § 808.02 requires nothing more.

The examiner's holding that claims 2, 3, 6 and 8-10 do not read on Figures 2A and 2B is, however, another matter. The examiner is the one who said that there are two distinctly claimed species, that of Figures 2A and 2B, and that of Figures 4A and 4B. Yet original claims 2, 3, 6 and 8-10 were original claims. Therefore, it would seem that either there is a third species defined by those claims which the examiner neglected to list in the original restriction requirement, or those claims in fact read on Figures 2A and 2B; the only difference between the "species" of Figures 2A and 2B and the "species" of Figure 4 which is set forth in the disclosure and in the claims is the cap in Figure 4.

The conclusion is inescapable that the examiner's holding in which he withdrew claims 2, 3, 6 and 8-10 from consideration was erroneous; either the examiner failed to offer petitioner the opportunity to elect the species defined by those claims, or the examiner erred in holding that they are not part of the disclosure of the species of Figures 2A and 2B. In fact, it is clear that all of the claims in fact read on Figures 4A and 4B, since the container illustrated therein is in fact "the container" described with respect to the various Figure 2 drawings, and would therefore include the features shown therein and described in the written specification. In actuality, it appears to the undersigned that there aren't two species of invention in this application at all, but rather a combination including a drinking vessel and a cap, and a subcombination defined by the drinking vessel *per se*. And therefore, not only is it deemed proper to hold that claims 2, 3, 6 and 8-10 should have been examined in this application, but the claim 7 should likewise have been examined since the examiner has not convincingly established two way distinctness between claim 7 and claims 1-6 and 8-10.

As to the drawings, a review of the original disclosure and of the formal drawings appended to the petition is convincing that the formal drawings do not illustrate subject matter which was reasonably conveyed as having been in the possession of petitioner on the day that this application was filed. Therefore, the examiner's holding to the contrary is deemed to be clearly erroneous, and the formal drawings attached to the petition will be entered, subject to satisfaction of the formal drawing standards of 37 CFR 1.84.

Accordingly, the petition will be granted to the extent that:

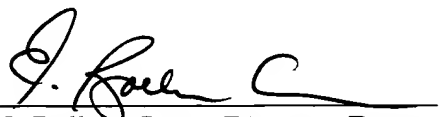
- a. The election of species requirement will be withdrawn, and all of the pending product (or apparatus) claims will be examined.
- b. The formal drawings attached to the petition will be entered.

The petition is denied with respect to the examiner's requirement to restrict between claims 1-10 and claims 11-17, the latter being a method of using the device recited in claims 1-10. However, The application is being forwarded to the Head Supervisory Applications Examiner for:

- a. A refund of the \$130.00 petition fee.
- b. Entry of the Notice of Appeal filed on November 4, 2002 as paper No. 9
- c. Entry of the change of correspondence address as paper No. 11 (both the correspondence address and attorney docket number must be changed in the PALM system.)

Thereafter, the application will be forwarded to the Supervisory Patent Examiner of Art Unit 3727 who will insure that the next action in this application is not inconsistent with this decision.

PETITION GRANTED-IN-PART



E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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